

Remarks

Upon entry of the above amendments this application will contain claims 7-9, 11-20, 23, and 36-39 pending. This application entered the US national stage with claims 1-29. In a preliminary amendment, claims 24-29 were canceled and new claims 30-35 were added. In a response to a Restriction Requirement, claims 1-6, 10 and 31-35 were canceled and claims 36-39 were added. In the present Submission, no claims have been canceled, claims 40-42 have been added. It is believed that this application is now in condition for allowance; timely reconsideration leading to withdrawal of all rejections is requested.

I. Election/Restriction

Claims 36-38 were considered to be within the scope of elected Group I invention. Claims 14-20, 23, and 39 were considered to be withdrawn because there was now allowable generic or linking claim.

The applicants request rejoinder of these claims. As discussed more fully below, it is believed that claim 36 is allowable and should be considered as a generic or linking claim for the invention claimed in each of claims 14-20, (and the new claims 40-43.)

Further the applicants also request rejoinder of the method claims 23 and 39 upon indication of an allowable compound claim.

II. Rejections under 35 USC §112, second paragraph

Claims 7-9 and 36 were rejected under 35 USC §112, second paragraph as indefinite for reciting ester prodrugs.

It is believed that the claimed invention, including prodrugs of the claimed compounds, is adequately defined in the application, specifically at pages 190-193. (Unless specifically noted to the contrary all citations to the present applications or specification refer to PCT application WO 05/0519,838, published 9 June 2005.) However in order to advance the prosecution of this application, claims 7-9 and 36 have been amended to delete reference to ester prodrugs. Withdrawal of the rejection of claims 7-9 and 36 is requested.

III. Rejections under 35 USC §112, first paragraph

Claims 11-13 and 36 were rejected under 35 USC §112, first paragraph; it was stated that the specification was not enabling for the plurality of compounds claimed. It is believed that the invention as previously claimed is adequately enabled and supported; however, in order to advance the prosecution of the application, claim 36 has been amended.

Claim 36 has been amended as follows: specifically L_{P2} now refers to $-(CH_2)_m-CH(OH)-$, and $-(CH_2)_m-C(O)-$; Z_p is a branched C_3-C_5 alkyl group; and Z_{FP} refers to a subset of the original variables that more closely mirror the exemplified compounds. It should be noted that Z_{FP} now includes $-C(O)NMe_2$, $-OSO_2(C_1-C_5 \text{ alkyl})$, $-SO_2(C_1-C_5 \text{ alkyl})$ and $-CH_2S(O)_2Me$, $-CH_2S(O)_2Et$, and $-CH_2S(O)_2iPr$. These variables have been reinstated and can be found in original claim 1. For additional support see examples 5, 6, 40, 41, 49, and 51.

In light of the above comments and the amendments to claim 36, it is believed that claim 36 is patentable. Claims 11-13 depend from claim 36. Therefore, withdrawal this rejection is requested.

III. Conclusion

In light of the above amendments and comments withdrawal of all rejections and timely reconsideration leading to allowance of all pending claims are respectfully requested. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Submission or other issues that may be resolved in that fashion.

Respectfully submitted,

/James B. Myers/

James B. Myers
Attorney for Applicants
Registration No. 42,021
Phone: 317-276-0755

Eli Lilly and Company
Patent Division
P.O. Box 6288
Indianapolis, Indiana 46206-6288

September 4, 2008